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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,625	01/22/2004	Yaacov Almog	600204528-XUDS-A	7724

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EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/763,625

Applicant(s)

ALMOG ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 3/21/05.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/529,289.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Election***

1. This action is in response to the provisional election mailed March 24, 2005. (Group I) Claims 1-30 were provisionally elected rendering (Group II) Claims 31-37 withdrawn to a non-elected invention.

### ***RESPONSE TO REQUEST FOR RECONSIDERATION***

2. Applicant's election with traverse of method of making a coated substrate (Group II) is acknowledged. The traversal is on the ground(s) that "the term overcoating is a broad term that encompasses *overcoating the media with an extruded overlayer coating*." Applicant lacks support for this ascertainment as there is extrusion is not mentioned or supported by the instant specification or the instant claims. Examiner maintains overcoating the media with an extruded overlayer coating is a materially different process than simply overcoating the media with an overlayer coating. Applicant further argues claim 33 should not be in Group II as it directly claims using the substrate of claim 1 or 19. Claim 33 is a process claim that utilizes the substrate of claim 1 or 19 and remains a process claim in Group II. The search of the 2 classes and subclasses would entail the requisite serious burden as the search for method of making is not the same as the article search. Additionally, the steps used in the method claims would not be expected to appear in the class/subclass of the product claims. Every substrate is not made using the same method steps.

The requirement is deemed proper and is therefore made **FINAL**.

### ***Objections***

3. Claims 1-2 are objected to because of the following informalities: In instant claim 1, it is unclear what is meant by "particulate matter mad substantially wax and pigment free". Additionally, in instant claim 2, the phrase, "paniculate matter" is unclear. The phrase has been interpreted as particulate. Appropriate correction is required.

### ***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lever et al. EP 0458481.

Lever discloses a substrate suitable for printing a toner image thereon comprises a film or sheet (paper), which is inclusive of plastic material, such as biaxially oriented polypropylene (BOPP), polyethylene, polyvinylchloride, polyethylene terephthalate (PET), and polycarbonate (page 2, lines 23-58) where the sheet . Lever also discloses a underlayer coating, the lacquer layer, comprises a polymer material which has crosslinkable functional groups, such as amine and trihydroxy silyl groups (page 3, lines 2-9), and an overlayer coating, the toner image receptive layer, comprises a polymer

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material, such as styrene butadiene copolymer and polyvinyl pyridine and acrylic acid, to which a toner image can be fused and fixed (page 4, line 42-page 5, line 3). The overlayer coating is substantially free of wax and particulate matter. The outer surface of the multilayer composite comprising printing media (page 3, lines 22-25).

Lever does not disclose the overlayer has to be free of particulate matter, wax or pigment, or the underlayer has to be free of particulate matter.

However, particulate matter, wax and pigment are well known optional additives for the image receiving substrates. Addition of these additives depends on the application of the substrates. As indicated in Level, page 3, line 10, the lacquer layer (underlayer) preferably additionally comprises finely particulate materials when the disclosed substrate is used as a drafting materials (depends on the application of the substrate). Therefore, absence of evidence that the claimed overlayer or underlayer being free of particulate matter (or wax, pigment) is critical, it would have been obvious to one of ordinary skill in the art to decide whether to use or not use the optional additives, such as particulate matter, wax or pigment, when it is applicable. Lever does not specify that the weight per square meter or percentage weight of the materials of the underlayer and overlayer. However, Lever discloses that same and/or similar materials used in the underlayer and overlayer. The cited document discloses a composition prepared from the same components as claimed in the present application except for the particular amounts and parameters. The claimed parameters are expressed differently and thus may be distinct from disclosed, it is incumbent upon applicants to establish that such difference is unobvious. Therefore, it would have been obvious to

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one having ordinary skill in the art at the time of the invention to employ the particular amounts and/or parameters as claimed, since it is well-established that merely selecting proportions and ranges is not patentable absent a showing of criticality. In re Becket, 33 USPQ 33, and In re Russell, 169 USPQ 426. In instant claims 24-25, the phrases, "the acidity of the copolymer has been reduced" and "the acidity of the copolymer has been reduced by saponification" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence Ferguson  
Patent Examiner  
AU 1774



RENA DYE  
SUPERVISORY PATENT EXAMINER

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6/13/05